

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Lawrence N Taugher

Serial No.: 08/823823

Filing Date: Mar 25, 1997

Title: Write Protect For Rewritable Compact Disks And Digital Video Disks

Examiner: Ali Neyzari

Group Art Unit: 2752

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ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- (X) Response/Amendment (X) Petition to extend time to respond
(X) New fee as calculated below () Supplemental Declaration
() No additional fee (Address envelope to "Box Non-Fee Amendments")
() Other: (fee \$)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS	11	MINUS	20	= 0	X \$18	\$ 0
INDEP. CLAIMS	3	MINUS	3	= 0	X \$78	\$ 0
[] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$260	\$ 0
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$380.00	3RD MONTH \$870.00	4TH MONTH \$1360.00		\$ 110
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 110

Charge \$ 110 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit: 4/3/00

Typed Name: Tara A. Schulze

Signature: 

Respectfully submitted,

Lawrence N Taugher

By 

Augustus W Winfield

Attorney/Agent for Applicant(s)

Reg. No. 34,046

Date: 3/31/00

HEWLETT-PACKARD COMPANY
IP Administration, Mailstop 20BN
P.O. Box 10301
Palo Alto, California 94303-0890

#19 Received
PATENT APPLICATION

ATTORNEY DOCKET NO. 10970451.4

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Lawrence N. Taugher

Serial No.: 08/823,823

Filing Date: 03/25/97

Title: WRITE PROTECT FOR REWRITABLE COMPACT DISKS AND DIGITAL VIDEO DISKS



Examiner: Ali Neyzari

Group Art Unit: 2752

THE ASSISTANT COMMISSIONER OF PATENTS
Washington, D.C. 20231

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REMARKS IN RESPONSE TO OFFICE ACTION

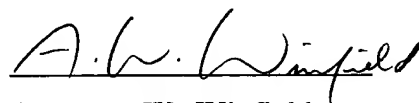
No amendments have been made. Claims 1-11 remain in the application.
Reconsideration and reexamination is respectfully requested.

In paper 17, claims 1-4 were rejected under 35 U.S.C. § 112, because of the phrase "capable of." Applicant respectfully traverses. The examiner cites MPEP § 2173.05(d). Applicant submits that MPEP § 2173.05(d) addresses only the phrases "such as" and "for example" and is not relevant to the phrase "capable of." In contrast, MPEP § 2173.05(g) cites *In re Barr*, in which the phrase "incapable of" was perfectly acceptable.

In paper 17, claims 1-11 were rejected under 35 U.S.C. § 103 in light of prior art disclosed in the specification. The examiner states: "To cover any area of a subject in order to prevent an operation to take place in such area is a common practice and nothing new in the art." Applicant respectfully traverses. Again, as discussed in the CPA, the examiner's argument is legally inconsistent with the requirements for a *prima facie* case for obviousness. The examiner assumes something (covering the power calibration area) that is not taught or suggested in the prior art. The fact that a feature is necessary for operation does not teach or suggest defeating the feature in a functional system. The invention must

be viewed not with the blueprint provided by the inventor, but in the state of the art that existed at the time. In all the prior art discussed in the application, and in all the prior art cited by the applicant or the examiner, only the presence of write protect devices is detected. Software can always ignore the presence of the devices. Accordingly, the state of the art at the time does not teach or suggest covering the power calibration area, or any other area required for functionality. The examiner has not provided any prior art in which a write protect device physically prevents a function required for writing. The examiner has failed to establish a *prima facie* case for obviousness. Again, in accordance with 37 C.F.R. 1.104 (d)(2), applicant requests an affidavit or objective references.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "A.W. Winfield", written over a horizontal line.

Augustus W. Winfield

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March 31, 2000

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